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10/529,864

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EXAMINER

TORRES, MARCOS L

ART UNIT

PAPER NUMBER

2617

NOTIFICATION DATE

DELIVERY MODE

10/08/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/529,864	Applicant(s) ROSADO, TERESA MARIA DE ANDRADE	
	Examiner MARCOS L. TORRES	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 4-1-05 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4-1-05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The information disclosure statement (IDS) filed on 4-1-05 is being considered by the examiner.

Drawings

2. The drawings are objected to because the poor quality of the scanned drawing makes difficult the examination. Please, submit a new copies of the drawing. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. Figure 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in

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compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claim 18 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1 already discloses a PABX .

5. Claims 5-6, 16 and 22 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims 5-6, 16 and 22 not been further treated on the merits.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not

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described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It appears that the specification fails to disclose how the programmable mobile phone is connected and communicate as a PABX extension and how the PABX is going to access the mobile network as defined in claim 1. In addition, the specification only discloses the goals and benefits of using a PABX system.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claim 1, the language of the claims is unclear because the full claim appears to be the preamble leaving no body with active limitations such that there is no clear distinction between the preamble and the body of the claim. For examination on the merits the claim will be interpreted as best understood. The claim is also directed to a system however is a method of using a device is claimed. It is unclear if the claim is directed to a system or it is a method.

11. Regarding claim 2, the phrase "like... and others" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

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12. Regarding claims 4 and 10, the phrase "other frequencies allowed by each country's law" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "other frequencies allowed by each country's law "), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). At the same time the first two choices are communication systems, the other two choices are frequency bands and the last one are frequencies. It is unclear scope of the claim due to the different scopes of choices. Also, please note that it is deemed that the invention is lawful [thereby using allowed frequencies], inventions not lawful are non-statutory.

13. Claim 8 recites the limitation "the PABX installed transmitter" in the second line. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the examiner what means the term "to switch the network function with extension."

15. Claim 18-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It seems that they are device claims depending on system claim; it is unclear if the claims are directed to a device or system. If the claim 18 is directed to a device the examiner invites the applicant to write the claim as independent.

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16. Claims 17 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At the last part of the claim they are several functions, however the claim does not specify if the system have to perform such function.

17. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. The invention is limited by the claim, is unclear the scope of the drawings.

Claim Rejections - 35 USC § 101

18. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

19. Claims 20-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because the claims are directed to software, which is considered as a program, per se, claim and it is non-statutory.

Claim Rejections - 35 USC § 102

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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21. Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by the admitted prior art.

As to claim 1, The admitted prior art discloses a communication system between a mobile phone [PHS DECT] and a PABX, characterized in that it allows any programmable mobile phone to connect and communicate as a PABX extension [see page 1, lines 15-18], making and receiving phone calls [see page 2, line 30], as well as accessing all services of the referred PABX, as an internal extension of the referred PABX [see page 3, lines 1-17], with the referred PABX communicating with the referred mobile phone directly through the mobile network, the communication's transmission line between the referred mobile phone and the referred PABX is established by accessing mobile networks and without needing to access of other network [see page 3, lines 18-21; page 4, lines 5-9] fixed networks of the following type:, ISDN, IP or direct lines [see page 2, lines 1-5].

22. Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Forte.

As to claim 1, Forte discloses a communication system (see fig. 1) between a mobile phone [70] and a PABX [14], characterized in that it allows any programmable mobile phone to connect and communicate as a PABX extension, making and receiving phone calls, as well as accessing all services of the referred PABX, as an internal extension of the referred PABX, with the referred PABX communicating with the referred mobile phone directly through the mobile network, the communication's transmission line between the referred mobile phone and the referred PABX is established by accessing mobile networks and without needing to access fixed

networks of the following type: PSTN, ISDN, IP or direct lines [see par. 0007, 0018-0026]..

As to claim 2, Forte discloses a System according characterized in that the communication's transmission line between a mobile phone and a PABX is a cellular oriented communication like GSM, TDMA, CDMA, AMPS [see par. 0023].

As to claim 4, Forte discloses a system characterized in that the communication's transmission line between a mobile phone and a PABX is a radio communication [see par. 0023].

As to claim 7, Forte discloses a System characterized in that it allows the mobile phone to have also access to PABX authorized services [see par. 0022].

As to claim 8, Forte discloses a System characterized in that it comprises a PABX [14], a programmable mobile phone compatible with the PABX installed transmitter and a transmission line also compatible with the PABX installed transmitter.

As to claim 9, Forte discloses a System characterized in that the PABX has fixed and mobile network circuits [fig. 1, items 16, 20 and 22, 30] and fixed and mobile extension circuits [see fig. 1, item 82-88, 89, 90].

As to claim 10, Forte discloses a System characterized in that the PABX has one or more transmitters [see par. 0023].

As to claim 11, Forte discloses a system characterized in that the mobile phone is compatible with the PABX installed transmitter [see par. 0023].

As to claim 12, Forte discloses a system characterized in that the transmission line is compatible with the PABX installed transmitter [see par. 0029-0030].

As to claim 13, Forte discloses a System characterized in that the PABX comprises detection circuits to identify the mobile phone after the communication establishment [see par. 0029].

As to claim 14, Forte discloses a System characterized in that the mentioned identification is made by a code sent through the mobile phone [see par. 0029].

As to claim 15, Forte discloses a System according to claim 13, characterized in that the mentioned identification is done automatically [see par. 0029].

As to claim 17, Forte discloses a System characterized in that the PABX comprises a central processing unit, CPU, which has a system functions developed software [see par. 0015; since the PBX process the calls inherently have a processor with instructions to process the calls].

Regarding claims 18 and 19, they are the corresponding device claims of the system claims 1 and 17. Therefore, they are rejected for the same reasons as shown above.

Regarding claims 20 and 25, they are the corresponding software claims of the system claims 17. Therefore, they are rejected for the same reasons as shown above.

As to claim 21, Forte discloses allowing controlling the mobile phone identification through system detectors and after making that identification, to charge that mobile phone with an extension number which corresponds to the mobile phone identification in the CPU memory [see par. 0029].

Regarding claims 23-24, the Forte system is capable of performing those functions (see par. 0015-0033).

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

25. Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forte in view of Freeny Jr. US 20030153352A1.

As to claim 3, Forte does not specifically disclose a system characterized in that the communication's transmission line between a mobile phone and a PABX is a satellite communication. In an analogous art, Freeny Jr. discloses a system characterized in that the communication's transmission line between a mobile phone and a PABX is a satellite communication [see par. 0023]. Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to use any common available transmission line to bring the same predictable result of carrying the communication.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCOS L. TORRES whose telephone number is (571)272-7926. The examiner can normally be reached on 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-252-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/
Supervisory Patent Examiner, Art Unit 2617

/Marcos L Torres/
Examiner, Art Unit 2617